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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/548,728	04/13/2000	Michael A. Epstein	PHA 23,671	7174
24737	7590	10/06/2004	EXAMINER	
PHILIPS INTELLECTUAL PROPERTY & STANDARDS			REVAK, CHRISTOPHER A	
P.O. BOX 3001				
BRIARCLIFF MANOR, NY 10510			ART UNIT	PAPER NUMBER
			2131	

DATE MAILED: 10/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/548,728	EPSTEIN, MICHAEL A. <i>[Signature]</i>
	<b>Examiner</b>	<b>Art Unit</b>
	Christopher A. Revak	2131

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 06 June 2004.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-14 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All
  - b) Some \*
  - c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### ***Response to Arguments***

1. Applicant's arguments with respect to claims 1-14 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1,2,4-7, and 9-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Ananda, U.S. Patent 5,638,513.

As per claim 1, it is disclosed by Ananda of a method comprising communicating a copy of content material to a receiving device. A security challenge is communicated to the receiving device when the copy of the content material is communicated to the receiving device (col. 2, lines 47-58; col. 3, lines 12-14; col. 14, lines 29-32; col. 22, lines 50-54). A security response, based on the security challenge, from the receiving device when the copy of the content material is removed from the receiving device (col. 9, line 66 through col. 10, line 10).

As per claim 2, Ananda teaches of certifying of the receiving device before communicating the copy of the content material to the receiving device (col. 3, lines 12-14; col. 11, lines 2-25; and col. 12, lines 29-45).

As per claims 4 and 5, it is disclosed by Ananda of generating a random number, encrypting the random number (via a public key of a public-private key pair) that is associated with the receiving device to form the security challenge and the security response includes the random number. The receiving device is verified before communicating the copy of the content material to the receiving device wherein certification of the receiving device includes encryption (via a public key of a public-private key pair) of the receiving device (col. 11, lines 2-25 and col. 12, lines 29-45).

As per claim 6, Ananda discloses of a catalog controller that provides a limited number of simultaneous copies of content material to a receiving device. An encrypter that is configured to provide a security challenge to a receiving device when the catalog controller provides a security challenge to a receiving device to provide a copy of the content material. A return verifier receives a security response from the receiving device when the copy of the content material is removed from the receiving device and notifies the catalog controller whether the security response corresponds to an appropriate response to the security challenge (col. 2, lines 47-58; col. 3, lines 12-14; col. 9, line 66 through col. 10, line 10; col. 11, lines 2-25; and col. 12, lines 29-45; col. 14, lines 29-32; and col. 22, lines 50-54).

As per claim 7, Ananda teaches of a certification verifier that is configured to verify a certification of the receiving device. A catalog controller is further configured to

provide the content material in dependence upon the certification of the receiving device (col. 3, lines 12-14; col. 11, lines 2-25; and col. 12, lines 29-45).

As per claim 9 and 10, Ananda discloses of an encryptor configured to encrypt a random number (via a public key of a public-private key pair) that is associated with the receiving device to form a security challenge. The return verifier is configured to compare the security response to the random number to determine whether the security response corresponds to the appropriate response to the security challenge. A certification verifier is configured to verify a certification of the receiving device and the catalog controller is configured to provide the content material in dependence upon the certification of the receiving device. The certification of the receiving device uses encryption (includes a public key of the public-private key pair of the receiving device)(col. 11, lines 2-25 and col. 12, lines 29-45).

As per claim 11, the teachings of Ananda recite of a receiving device that receives content material and a corresponding security challenge from a check-out/check-in device. Memory is configured to store the content material and the corresponding security challenge. A security device is configured to erase the content material from the memory and communicate a security response to the check-out/check-in device based on the security challenge that is associated with the content material (col. 2, lines 47-58; col. 3, lines 12-14; col. 9, line 66 through col. 10, line 10; col. 11, lines 2-25; and col. 12, lines 29-45; col. 14, lines 29-32; and col. 22, lines 50-54).

As per claim 12, Ananda teaches of a security device that is configured to communicate certification of the receiving device to the check-out/check-in device to enable the check-out/check-in device to provide content material to the receiving device (col. 11, lines 2-25 and col. 12, lines 29-45).

As per claims 13 and 14, it is disclosed by Ananda of a security device that includes a decrypter that decrypts the security challenge (via a private key of a public-private key pair that is associated with the receiving device) to form the security response. The security device is further configured to communicate a certification of the receiving device to the check-out/check-in device to enable the check-out/check-in device to provide the content material to the receiving device. The certification of the receiving device uses encryption (includes a public key of a public-private key pair) (col. 11, lines 2-25 and col. 12, lines 29-45).

#### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 3 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ananda, U.S. Patent 5,638,513 in further view of Bereiter, U.S. Patent 5,754,763.

The teachings of Ananda disclose of managing the distribution of content material based on certification of a receiving device that is issued a security challenge.

The teachings of Ananda are silent in disclosing of maintaining a count of the simultaneous copies of the content material, including incrementing the count when the copy of the content material is communicated to the receiving device and decrementing the count when the security response is received from the receiving device, wherein communicating the copy of the material is dependent upon the count of the simultaneous copies. Bereiter discloses of maintaining a count of the simultaneous copies of the content material, including incrementing the count when the copy of the content material is communicated to the receiving device and decrementing the count when the security response is received from the receiving device, wherein communicating the copy of the material is dependent upon the count of the simultaneous copies (see abstract; col. 1, lines 6-10; column 8, lines 44-67; and col. 9, lines 1-7). It would have been obvious to a person of ordinary skill in the art at the time of the invention to have been motivated to apply the counting of simultaneous copies of content material. Bereiter recites motivation for this concept by disclosing of the need to audit the use of licensed software without adding overhead to the system and without requiring user interaction and it helps determine if software usage has exceeded a given authorization (col. 2, lines 6-9 and col. 3, lines 10-19). The teachings of Ananda are directed towards the protection of content material and it is obvious that the teachings of Bereiter add additional means of protection by monitoring content material to determine if authorization has been complied with based on the number of copies being used.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher A. Revak whose telephone number is 571-272-3794. The examiner can normally be reached on Monday-Friday, 6:30am-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on 571-272-3795. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Christopher Revak  
AU 2131

*CR*  
*CR*  
9/30/04

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September 30, 2004